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Patent Application
Attorney Docket No. D/A1503

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex Parte: Thomas W. Smith & Kathleen M. McGrane

Application No.: 10/036,590

Appeal No.: 2006-0049

Examiner: Callie Shosho

Art Unit: 1714

Title: INK COMPOSITIONS WITH IMPROVED
LIGHTFASTNESS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

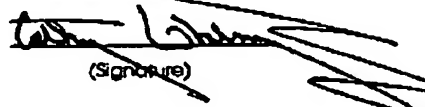
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February 28, 2006
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Cathy Whitney

(Name of applicant, assignee,
or Registered Representative)


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PETITION FOR RECONSIDERATION

This Petition is filed in response to the Decision of the
Board of Patent Appeals and Interferences mailed January 31, 2006 in
the above identified application.

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REMARKS

In its decision upholding the Examiner's rejections, the Board has, in the instances of the rejection of claims 1 to 8, 11 to 20, and 22 to 25 as being unpatentable over Gundlach et al. in view of Vieira et al., the rejection of claims 1 to 7, 11 to 20, and 22 to 25 as being unpatentable over Gundlach et al. in view of Yokoyama et al., and the rejection of claims 1 to 4 and 10 to 25 as being unpatentable over Gundlach et al. in view of either Bergthaller et al. or Ma et al., concluded that since both of the references relied upon by the Examiner, namely Gundlach '505 and (Vieira/Yokoyama/Bergthaller/Ma), are directed to improving lightfastness in inks, one of ordinary skill in the art would be motivated to combine the teachings of these references, thereby arriving at the instantly claimed invention.

For example, as stated at page 14 of the decision, the Board has stated that Gundlach recognizes that a need remains in the art for ink compositions with improved lightfastness and that an objective of Gundlach is to provide ink compositions with improved lightfastness. The Board then concludes that a person of ordinary skill in the art was aware of the problems associated with anionic dye ink jet compositions, including the need for improved lightfastness, and that the person of ordinary skill in the art desiring the benefits of Gundlach's improved anionic dye ink jet composition would have been motivated to include the anionic lightfastness agent of Vieira therein, since Vieira teaches that such agents provide improved lightfastness for anionic dye jet printing inks.

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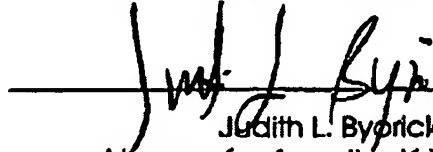
The Board has applied substantially similar reasoning to the rejections involving Gundlach in combination with Yokoyama, Bergthaller, and Ma.

Appellants disagree with this position. One of ordinary skill in the art would not be motivated to add an additional lightfastness agent to the ink of Gundlach because Gundlach teaches that the ink therein already has improved lightfastness. The quoted portion (from column 6) of Gundlach stating that a need remains in the art for ink compositions with improved lightfastness also states that an objective of Gundlach is to provide ink compositions with improved lightfastness. While Gundlach states the need for improved lightfastness, Gundlach also purports to solve the problem of improved lightfastness. Accordingly, one of ordinary skill in the art would have no reason to add an additional lightfastness agent to the ink of Gundlach et al. based on the teachings of the references viewed in combination at the time the present invention was made.

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For these reasons, Appellants respectfully request reconsideration and withdrawal of all grounds for rejection of the instant claims.

Respectfully submitted,


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JLB/cw
February 28, 2006

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Attorney Docket No.: D/A1503

Petition for Reconsideration.

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